

REMARKS

The Office Action mailed February 1, 2005 (Paper No. **None Assigned**) has been carefully reviewed and the foregoing amendments are made in response thereto. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Upon entry of the foregoing amendment, claims 1-9 and 11-30 are pending in this application. Claims 5 and 11-28 have been withdrawn from examination as being directed to a non-elected invention. Claims 1, 4, 11 and 19 have been amended. Claim 10 has been canceled. Claims 1-4, 6-9, 29 and 30 are under examination. Applicants reserve the right to pursue the canceled subject matter of the canceled or amended claims in a continuing or divisional application.

Support for the amendments to claim 1 is found in original claim 10, and elsewhere throughout the specification. Claim 4 has been amended to correctly claim antecedent basis. Claim 11, although withdrawn, has been amended to depend from claim 1 since claim 10 is cancelled herein. Claim 19 has been amended to correct grammatical errors. It is believed no new matter has been introduced by these amendments and entry is respectfully requested.

Other Matters

IDS

The Office has alleged the information disclosure statement (IDS) filed 6/9/03 fails to comply with 37 CFR § 1.98(a)(2). The Office has acknowledged consideration of the non-patent documents (Office Action, page 2, second full paragraph) without initialing the documents as being considered. Submitted herewith is a revised, complete PTO 1449 form and IDS for execution and return by the Examiner. Applicants note that document numbers 48, 53, 54 and 65 are newly cited documents and a copy of each document is submitted herewith. The Office has

acknowledged receipt of the other documents, thus additional copies of the listed documents have not been submitted herewith (Office Action, page 2, second full paragraph).

The Office alleges that “the information disclosure statement filed 6/9/03 also fails to comply with 37 CFR § 1.98(a)(2) which requires a legible copy of each US and foreign patent, each publication or that portion which caused it to be listed and all other information or that portion which caused it to be listed.” The Office further states it (WO/95 21259) has been placed in the file but not considered. Since Applicants have provided a copy (said copy being acknowledged by the Office), Applicants respectfully request consideration of the WO/95 21259 document. The PTO 1449 form submitted herewith correctly provides the information required of published foreign patent applications.

Disclosure Document 441607

Regarding Disclosure Document 441607, since the filing date of the disclosure document will not become an effective filing date of any patent application, Applicants have removed the reference to Disclosure Document 441607 from their priority claim on page 1.

Drawings

Submitted herewith is a Formal set of figures which are believed to overcome the objections. Reconsideration and withdrawal of the objection is respectfully requested. Attached hereto is a Petition for Submission of Formal Figures.

Claim Objections

Claims 1 and 4 have been amended as necessary. The amendments to claim 1 are believed to cure the objection to claims 2-4, 29 and 30. Reconsideration and withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. § 103

The Office rejected claims 1-4, 6-10, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Hallenbeck (WO 96/17053)[Hallenbeck, 1996] in view of Park *et al.* (Cancer Research 54:

1775-1781(1994)) [Park] and Leavitt (WO 94/17182) [Leavitt, 1994] alone or both in combination with Mueller *et al.* (USPN 6,383,785; 1997) and Koerner *et al.* (USPN 6,033,856; March 1998). The rejection is respectfully traversed. Claim 1 is newly amended herein. Claim 10 is newly cancelled herein.

Briefly, the Office alleges it would have been obvious to one of ordinary skill in the art to have incorporated the L-plastin promoter into a CRAD of Hallenbeck operably linked to the E1 region in order to limit replication of the CRAD to specific types of tumors and that the L-plastin promoter could be used to target expression to specific tumor cells as taught by Park and Leavitt for treatment of mammary or ovarian carcinomas or pancreatic tumors as taught by Koerner and Mueller.

However, as the Office is aware, to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Office has used impermissible hindsight to construct a *prima facie* case of obviousness. Prior art may not be gathered with the claimed invention in mind. A statement that modifications of the prior art to meet the claimed invention would have been “obvious to one of ordinary skill in the art” at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

If the Office maintains this rejection, the Office is respectfully requested to point out with particularly an objective reason to combine the teachings of the references. In view of the amendments to the claims and arguments above, reconsideration and withdrawal of the rejection is respectfully requested.

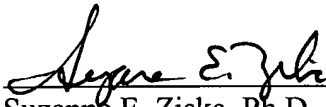
Conclusion

In view of the foregoing amendments and response, Applicants respectfully request withdrawal of the outstanding rejections and early notice of allowance to that effect. If the Examiner finds that a telephone conference would further prosecution of this application, she is invited to call the undersigned at her convenience.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **May 2, 2005**
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Respectfully submitted,
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